#38 4/10/02

Atty. Dkt. No. EPI3007B
(071344-0302)
formerly TSRI 184.2CON1

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Hein et al.

Title: TRANSGENIC PLANTS EXPRESSING ASSEMBLED SECRETORY ANTIBODIES

Appl. No.: 09/200,657

Filing Date: 11/25/1998

Examiner: C. Collins

Art Unit: 1638

CERTIFICATE OF FACSIMILE TRANSMISSION
I hereby certify that this paper is being facsimile transmitted to the United States Patent and Trademark Office, Washington, D.C. on the date below.

Bridge McDougall
(Printed Name)

(Signature)

September 6, 2002
(Date of Deposit)

RESPONSE TO RESTRICTION REQUIREMENT

Commissioner for Patents
Washington, D.C. 20231

Sir:

In response to the restriction requirement set forth in the Office Action mailed August 7, 2002, Applicant hereby provisionally elects Group II, Claims 79, 81-90, and 93-95, for examination, with traverse.

The Examiner has required restriction between Claims 43-44, 48, 53, 57-59, 79, 81-82 and 96-99 (Group I), drawn to a plant comprising cells containing nucleotide sequences encoding an antigen-specific immunoglobulin single polypeptide product containing at least an immunoglobulin heavy chain polypeptide or portion thereof and an immunoglobulin light chain or portion thereof and encoding a peptide linker therebetween and Claims 79, 81-90, and 93-95 (Group II), drawn to a plant comprising cells containing nucleotide sequence encoding an immunoglobulin single polypeptide product containing at least an immunoglobulin heavy chain polypeptide. Restriction was required because the Examiner believes that restriction is proper in this case because the nucleotide sequences

Examiner believes that restriction is proper in this case because the nucle tid s quences present in the transgenic plant cells in the two claim groups are different and that such difference has different effects such as in expression, and that the inventions have a separate status in the art as allegedly shown different classification and divergent subject matter. Applicant respectfully disagrees.

Restriction is appropriate if two or more independent and distinct inventions are claimed in one application. 35 U.S.C. §121. The Patent Office interprets §121 of the patent statute to allow restriction between two or more inventions only if they are able to support separate patents and they are either independent or distinct. MPEP § 803. The examiner is required to provide reasons and/or examples to support restriction. *Id.* It is also Patent Office procedure that even if inventions are determined to be independent or distinct, restriction should not be made if examination can be performed without a "serious burden" on the examiner. *Id.*

It is respectfully submitted that common to both of the above Groups is the requirement for immunoglobulin polypeptides to be expressed in plant cells and to form antigen specific immunoglobulin when co-expressed. Furthermore, the Examiner's reasoning for restricting the groups falls far short of the "serious burden" to search requirement. In particular, this case claims priority to several applications filed in the Patent Office as far back as 1989. A good many searches have already been made and the same art continues to be asserted in the various cases. Patentability can be determined for both of the Groups without the need for yet an additional search and the attendant costs of divisional filings. If the restriction is made final, Applicant reminds the Examiner of the impact of 35 U.S.C. 121, to render any different restricted groups non-obvious to each other.

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Therefore, in view f the above, it is respectfully requested that the restriction requirement be withdrawn and that the Claims of Group I and II be xamined together.

Respectfully submitted,

Date: September 6, 2002

By _____

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